

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed December 13, 2010. Currently, claims 5-31, 52, 54-56, 58-72, 74-76, and 78-95 remain pending of which claims 5-31 were previously withdrawn. Claims 52, 54-56, 58-72, 74-76, and 78-95 have been rejected. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 112

Claims 52, 54-56, 58-72, 74-76, and 78-85 were rejected under 35 U.S.C. 112, first paragraph, as failing to meet the written description requirement. The Examiner has asserted that the limitation “only a single layer of filter membrane”, added by amendment, was not adequately described in the application as originally filed. (Examiner’s emphasis.) Applicants respectfully disagree. It is believed that the Examiner has read the cited MPEP 2173.05(i): “The mere absence of a positive recitation is not basis for an exclusion.”, out of context. In context, the quoted sentence follows “If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d* mem., 738 F.2d 453 (Fed. Cir. 1984). Thus, in context, it is believed that the quoted sentence should be interpreted as: “The mere absence of a positive recitation is not basis for an exclusion *of the claimed matter*.”

In the current instance, a filter having a membrane is disclosed and thus provides the basis for a claim to a filter having a single membrane. In addition, the filter membrane is consistently referred to in the singular and with a singular article. The plural form “membranes” does not appear in the specification. Further, Fig. 3 is identified as a plan view of the filter system of Fig. 2 at page 4, line 3 and at page 7, lines 18-19. The latter text notes that Figure 3 depicts the filter without the membrane (singular) of Figure 2. Applicants direct the Examiners attention to the absence of an additional layer of filter membrane remaining in Figure 3 when the membrane of Figure 2 is removed. The removal of a membrane 328 to expose a frame devoid of additional

membrane layers is repeated in paired Figures 7-8. It is believed that one of ordinary skill in the art would readily appreciate the specification and drawings illustrate the removal of a single membrane.

2163.06 Relationship of Written Description Requirement to New Matter
“Stated another way, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.”

It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification. ... An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

MPEP 2163.04:

The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

Applicants respectfully submit that the Examiner’s statement that he did not find the supporting disclosure is inadequate as evidence or reasoning that one of ordinary skill in the art would not have properly interpreted the repeated recitation of a (singular) membrane, the lack of a reference to multiple membranes, the illustration of a singular membrane by removal thereof as illustrated in two pairs of figures, and the absence of embodiments which explicitly disclose multiple membrane layers to indicate the presence of a single membrane layer.

What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See *Hybritech Inc. v. Monoclonal Antibodies*,

Inc., 802 F.2d at 1384, 231 USPQ at 94. >See also *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1085 (Fed. Cir. 2005)(“The ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge.... As each field evolves, the balance also evolves between what is known and what is added by each inventive contribution.”).< If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating “the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient”). (MPEP 2163. II., 3., (a).) (Emphasis added.)

Further, even had more than one membrane layer been illustrated, that would suffice to support the claimed single layer as subsumed within the multiple membranes thereby supporting the amended claim. Applicants respectfully request that the rejections be withdrawn.

Claim Rejections – 35 USC § 103

Claims 52, 54, 55, 58-63, 70-72, 74, 75, 78-83 and 90-95 were rejected under 35 U.S.C. 103(a) as being unpatentable over Stanford et al. (U.S. Patent No. 6,840,950), hereinafter Stanford, in view of Brady et al. (U.S. Patent No. 6,565,591), hereinafter Brady.

Claims 56 and 76 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stanford et al. and Brady et al., as applied to claims 52 and 72, in view of Daniel et al. (U.S. Patent No. 5,814,064).

Claims 64-69 and 84-89 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stanford et al. and Brady et al., as applied to claims 52 and 72, in view of Mazzocchi et al. (U.S. Patent No. 6,605,1024).

After careful review, Applicant must respectfully traverse this rejection.

As an initial matter, and in answer to the Examiner’s Response to Arguments, Applicants assert that Stanford is prior art only under 35 U.S.C. 102(e), which is being relied upon in a rejection under 35 U.S.C. 103(a). Accordingly Stanford, used in a

rejection under 35 U.S.C. 103(a), may be disqualified under the commonly assigned/owned prior art provision of 35 U.S.C. 103(c).

As suggested by MPEP 706.02(I)(2) II.:

Application 10/044,368 and Patent 6,840,950 were, at the time the invention of Application 10/044,368 was made, owned by SciMed Life Systems, Inc.

As noted previously, U.S. Patent No. 6,840,950 to Stafford, Chin, Zhong, and Griego was assigned to SciMed Life Systems, Inc., with the assignment recorded at Reel 011694, Frame 0074 and Reel 012988, Frame 0012, with a name change to Boston Scientific SciMed, Inc. recorded on Reel 018505, Frame 0868. The current inventors of Application 10/044,368, Broome, Chandrasekaran, Daniel, and Mayberry, were, at the time of invention under an obligation of assignment to SciMed Life Systems, Inc., as evidenced by the assignment recorded at Reel 012911, Frame 0375, with a name change to Boston Scientific SciMed, Inc. recorded on Reel 018505, Frame 0868. Accordingly, both the patent and the application were commonly assigned/owned to/by SciMed Life Systems, Inc. at the time of invention.

It is believed that statements above suffice to establish common ownership for the purpose of § 103(c) and that an affidavit under either 37 CFR 1.131 or 37 CFR 1.132 is unnecessary in view thereof.

Therefore, Stanford et al. is disqualified as prior art in formulating the obviousness rejection under the provisions of 35 U.S.C. §103(c).

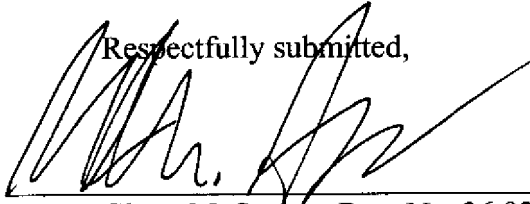
In the absence of Stanford et al., Brady et al., Daniel et al., and Mazzocchi et al. appear incapable of rendering the claims obvious, as they do not appear to teach or suggest all of the elements of the claims, as is required to establish a *prima facie* rejection. Accordingly, Applicants respectfully request that the rejections of claims 52, 54, 55, 58-63, 70-72, 74, 75, 78-83 and 90-95 be withdrawn.

In view of the foregoing, all pending claims are believed to be in condition for allowance. Further examination, reconsideration, and withdrawal of the rejections are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Date:

March 1, 2011

Respectfully submitted,



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